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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/696,635	10/25/2000	Kestutis Tautvydas	11536-001001/55190USA8A	4398
32692	7590	07/13/2006	EXAMINER	
3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427			COTTON, ABIGAIL MANDA	
			ART UNIT	PAPER NUMBER
			1617	

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/696,635		TAUTVYDAS ET AL.	
	Examiner		Art Unit	
	Abigail M. Cotton		1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-37, 39-45 and 52-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-37, 39-45 and 52-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2006 has been entered.

Claims 33-~~37~~, 39-45 and 52-57 are pending in the application and are being examined on the merits herein.

The rejection of the claims for obviousness-type double patenting over the claims of U.S. Patent Application Publication No. 10/659,571 is being withdrawn in view of the abandonment of the conflicting application.

Applicant's arguments with respect to the rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 39 is rejected under 35 U.S.C. 112, second paragraph, as having a lack of antecedent basis for the phrase "the vehicle" as recited in the claim. Claim 41, from which claim 39 depends, has been newly amended to delete any reference to a vehicle, and thus it is not clear what "vehicle" is being referred to in dependent claim 39. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 33, 36, 39-41, 43 and 52-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,098,694 to Komp et al, issued March 24, 1992, in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999.

Komp et al. teaches a natural deodorant composition comprising glyceryl laurate (glyceryl monolaurate), sorbic or benzoic acid (enhancer), and citric acid (see abstract, in particular), and thus teaches a composition comprising the fatty acid monoester derived from a C₈ to C₁₂ fatty acid and enhancer as recited in claim 41. Komp et al. teaches that the deodorant composition can comprise from 0.5-5% of glyceryl laurate and (see column 1, lines 62-68, in particular) and from 0.1 to 0.5% of sorbic or benzoic acid (see column 2, lines 3-10, in particular), and thus teaches the composition having amounts of the ingredients that meet the range limitations as recited in claim 41. Komp et al. further teaches that the composition can be made by simply mixing together the appropriate ingredients in the usual manner (see column 3, lines 18-21, in particular.)

Komp et al. does not specifically teach that the composition is provided in the form of a kit having a first container with the fatty acid monoester and a second container with the benzoic acid, as recited in claim 41.

Markey et al. teaches a dual bottle having two separable interlocked compartments (see abstract, in particular), and thus teaches a "kit" with first and second containers, as recited in claim 41. Markey et al. teaches that it is known that in modern consumer products, such as shampoos or conditioners, it may be desirable to keep one or more of the components separate until just before dispensing, which the dual bottle allows for (see column 1, lines 5-15, in particular.)

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the composition of Komp et al. in the two-container "kit" of Markey et al, because Komp et al. teaches that the ingredients of the composition can be mixed together in the usual manner, and Markey et al. teaches that it is known to provide components of consumer products in separate containers before mixing the ingredients together. Accordingly, it is considered that one of ordinary skill in the art would have been motivated to provide the ingredients of the composition of Komp et al. in the kit having the separate containers of Markey et al, with the expectation of providing a conventional and suitable means for the mixing and use of the composition.

Regarding claim 33, Komp et al. teaches the composition can comprise a solvent such as alcohol (see column 2, lines 30-35, in particular.) Regarding claim 36, Komp et al. teaches that the alcohol can be isopropanol (see column 2, lines 30-35, in particular.) Regarding claim 39, Komp et al. teaches that the carrier can be aqueous/alcoholic, and can comprise solvents such as isopropanol, ethanol and polyols (see column 2, lines 15-35, in particular.) Regarding claim 40, Komp et al. teaches the composition can comprise citric acid (see column 2, lines 9-15, in particular), which is a flavorant.

Regarding claim 43, Komp et al. teaches providing glyceryl monolaurate (see column 1, lines 63-68, in particular.) Regarding claim 52, Komp et al. teaches providing emollients such as PPG-15 stearyl ether, PPG-5 laureth 5, PPG-11 stearyl ether, and

Art Unit: 1617

others (see column 2, lines 35-40, in particular), which are surfactants. Regarding claims 53-54, Komp et al. exemplifies providing PPG-15 stearyl ether (a surfactant) in an amount of 4-6% (see column 3, lines 10-15, in particular), which is an amount that meets and/or overlaps with the limitations of the claims. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of surfactant provided in the composition, according to the guidance provided by Komp et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claims 55-56, Komp et al. teaches providing a carrier (vehicle) (see column 2, lines 15-35, in particular), and Markey et al. teaches that it is known to provide ingredients of consumer products in separate containers prior to mixing. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the vehicle in the same container as the fatty acid monoester with the expectation of providing a suitable formulation for the composition.

Claims 33, 35-36, 39-41, 43 and 55-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "Enhanced Inhibition of Listeria

Art Unit: 1617

monocytogenes by Glycerol Monolaurate with Organic Acids” by Oh et al, 1994, the Journal of Food Science, volume 59, no. 6, pages 1258-1261, in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999.

Oh et al. teaches that listeria monocytogenes can cause fatal human foodborne disease and is ubiquitous (see first full paragraph of Introduction section, in particular.) Oh et al. teaches that monolaurin, a food grade glycerol monoester of lauric acid, has broad spectrum antimicrobial activity in culture media (see paragraph bridging right and left hand columns of page 1258, in particular.) Oh et al. teaches that combinations of monolaurin with organic acids such as acetic acid, benzoic acid, citric acid and lactic acids were tested to determine the inhibitory effect on bacterial growth of the combinations in comparison to monolaurin by itself (see abstract and first full paragraph of right hand column of page 1258, in particular.) Oh et al. teaches that the results were that benzoic acid showed a synergistic interaction when combined with monolaurin on the inhibition of growth of bacteria (see final full paragraph of right hand column of page 1259, in particular.) Regarding the relative amounts of the monolaurin and benzoic acid, Oh et al. teaches that the concentrations of monolaurin and benzoic acid that are the minimal inhibitory concentrations (see Tables 1 and 2, in particular.) Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of monolaurin and/or benzoic acid provided in the composition, according to the guidance provided by Oh et al, to provide a composition having desired properties, such as desired antimicrobial

Art Unit: 1617

properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Oh et al. does not specifically teach that the composition is provided in the form of a kit having a first container with the fatty acid monoester and a second container with the benzoic acid, as recited in claim 41. However, Oh et al. does teach that the stock solutions of monolaurin and benzoic acid were separately prepared and were prepared "fresh" before each experiment (see page 1258, Preparation of Antimicrobial Agents, in particular.)

Markey et al. teaches a dual bottle having two separable interlocked compartments (see abstract, in particular), and thus teaches a "kit" with first and second containers, as recited in claim 41. Markey et al. teaches that it is known that in modern products it may be desirable to keep one or more of the components separate until just before dispensing, which the dual bottle allows for (see column 1, lines 5-15, in particular.)

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the composition of Oh et al. in the two-container "kit" of Markey et al, because Oh et al. teaches that the ingredients of the composition can be formulated "fresh" in separate stock solutions prior to mixing for use, and Markey

et al. teaches that it is known to provide components of products in separate containers before mixing the ingredients together. Accordingly, it is considered that one of ordinary skill in the art would have been motivated to provide the ingredients of the composition of Oh et al. in the kit having the separate containers of Markey et al, with the expectation of providing a conventional and suitable means for the mixing and use of the composition.

Regarding claims 33, 36, 39 and 55, Oh et al. teaches preparing a stock solution of benzoic acid in absolute ethanol (alcohol), which is a vehicle (see Preparation of Antimicrobial Agents, in particular.) Regarding claims 35, Oh et al. teaches that lactic acid also showed antimicrobial effects when combined with monolaurin (see second full paragraph of right hand column of page 1259, in particular), and accordingly it is considered that one of ordinary skill in the art would have found it obvious to combine the lactic acid with the monolaurin and benzoic acid with the expectation of achieving an antimicrobial effect. Note it is considered that "[I]t is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose.... [T]he idea of combining them flows logically from their having been individually taught in the prior art." *In re Kerkhoven*, 626 F.2d 846, 850, 205 USPQ 1069, 1072 (CCPA 1980.)

Regarding claim 40, Oh et al. teaches that lactic acid is a flavor enhancer (flavorant) (see paragraph bridging pages 1259-1260.) Regarding claim 43, Oh et al.

Art Unit: 1617

teaches providing monolaurin (glycerol monolaurate), as discussed above. Regarding claim 56, Oh et al. teaches that the fatty acid monoester and vehicle can be provided to give antimicrobial effects, and can be prepared separately from benzoic acid in a "fresh" preparation, and Markey et al. teaches that is known to provide ingredients in separate containers prior to mixing. Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the monolaurin and vehicle together in the same container, and separately from benzoic acid, with the expectation of providing a suitable formulation.

Claims 34, 37, 42, 52-54 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over the article entitled "Enhanced Inhibition of *Listeria monocytogenes* by Glycerol Monolaurate with Organic Acids" by Oh et al, 1994, the Journal of Food Science, volume 59, no. 6, pages 1258-1261, in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999, as applied to claims 33, 35-36, 39-41, 43 and 55-56 above, and further in view of U.S. Patent No. 5,460,833 to Andrews et al, issued October 24, 1995.

Oh et al. and Markey et al. are applied as discussed for claims 33, 35-36, 39-41, 43 and 55-56 above, and teach an antibacterial composition suitable for use with food to protect against food-borne illnesses that comprises monolaurin (glycerol monolaurate) and benzoic acid, and that can be provided in a two compartment kit.

Oh et al. and Markey et al. do not specifically teach that the composition can comprise a chelating agent, as in claim 34. Oh et al. and Markey et al. also do not specifically teach that the composition can comprise a surfactant as in claims 37, 42 and 52-54. Oh et al. and Markey et al. also do not specifically teach that the composition can comprise a non-aqueous vehicle, as recited in claim 57.

Andrews et al. teaches a composition to reduce microbial contamination of processed meat (see abstract, in particular.) Andrews et al. teaches that the antimicrobial and disinfection composition desirably comprises a fatty acid monoester, such as a glycerol monoester of lauric acid (monolaurin) (see column 2, lines 30-47 and column 4, lines 25-27, in particular.)

Regarding claim 34, Andrews et al. teaches that the food disinfecting composition can comprise an acid or chelating agent, such as ethylenediaminetetraacetic acid (see column 4, lines 45-55, in particular.) The Examiner notes that Andrews et al. also teaches that the disinfecting composition can comprise acids such as acetic acid, tartaric acid, lactic acid, and others (see column 4, lines 43-50, in particular.)

Regarding claims 37, 42 and 52, Andrews et al. teaches that the food disinfecting composition can comprise food grade surfactants, such as anionic and nonionic surfactants, such as dioctyl sodium sulfosuccinate and sodium lauryl sulfate (see

Art Unit: 1617

column 5, lines 4-14, in particular.) Regarding claims 53-55, Andrews et al. teaches that the surfactants can be provided in an amount of from 0.001 to 1% (see column 5, lines 4-15, in particular), which is an amount that meets and/or overlaps with the ranges as recited in the claims. Furthermore, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to vary and/or optimize the amount of the surfactants provided in the composition, according to the guidance provided by Andrews et al, to provide a composition having desired properties. It is noted that "[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation." In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955.)

Regarding claim 57, Andrews et al teaches that the disinfectant composition can be formulated in a nonaqueous vehicle (see column 2, lines 47-50, in particular.)

Accordingly, it is considered that one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the ingredients such as the chelating agents and surfactants of Andrews et al. in the antibacterial composition of Oh et al. and Markey et al, and/or to provide the nonaqueous vehicle of Andrews et al, because Oh et al. and Markey et al. teach a an antimicrobial composition containing monolaurate that is suitable for use with food, and Andrews et al. teaches food disinfecting formulations that can comprise monolaurin. Thus, one of ordinary skill in the art would have been motivated to provide the components of the antimicrobial

Art Unit: 1617

composition of Andrews et al, and/or the nonaqueous vehicle, in the composition of Oh et al. and Markey et al, with the expectation of providing ingredients and vehicle that are compatible with monolaurin in the composition, and that are compatible with food disinfecting compositions in general, and thus formulating an antimicrobial composition suitable for use with food.

Claims 33, 35-37, 39, 41-51 and 52-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,968,539 to Beerse et al. in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999.

Beerse et al. discloses an antimicrobial composition comprising (i) an antimicrobial active including glyceryl laurate (as in claim 43) (see column 5, line 20, in particular) in 0.0001-5 wt % (see also abstract, in particular), which overlaps with the range claimed herein; (ii) the anionic surfactants herein in an amount of 1-80 wt % (see column 8, line 41 through column 9, line 45 and column 2, lines 36-40 and 64, in particular), as in claims 37 and 42 and in a range that overlaps with the ranges in claims 52-54; a vehicle such as water in an amount of 3-98.8 wt% (a diluent, as in claim 45) (see column 2, line 38, in particular); (iii) a proton donating agent, an organic acid such as salicylic acid (enhancer) as well as, tartaric acid, adipic acid, succinic acid and citric acid, as in claims 33 and 35, in 0.1-12 wt%, thus overlapping with the range recited herein (see abstract, column 14, lines 61-54, in particular); and ethanol, as in claims 33, 36 and 39 (see claims 1-19 and Examples at columns 24-28, in particular.) Accordingly,

Beerse et al teaches a composition with antimicrobial and antibacterial effects, as recited in the claims and in claim 44.

Beerse et al. does not expressly exemplify the composition comprising the specific agents, glyceryl laurate and salicylic acid, as instantly claimed. Beerse et al. also does not expressly disclose the employment of a kit for the composition therein.

However, one having ordinary skill in the art at the time the invention was made would have been motivated to provide the specific agents, glyceryl laurate and salicylic acid, in the antimicrobial or antibacterial compositions of the prior art, since Beerse et al. provides a reasonable expectation of success for all antimicrobial actives listed in the patent, including glyceryl laurate, all organic acids including salicylic acid, tartaric acid, adipic acid, succinic acid, and citric acid, as used in the antibacterial compositions therein, even though Beerse et al. does not exemplify glyceryl laurate and salicylic acid as preferred agents. It has been well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to a person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 69, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983.)

Regarding the kit having separate containers, it is noted that Markey et al. teaches a dual bottle having two separable interlocked compartments (see abstract, in particular), and thus teaches a "kit" with first and second containers, as recited in claim 41. Markey et al. teaches that it is known that in modern consumer products, such as shampoos or conditioners, it may be desirable to keep one or more of the components separate until just before dispensing, which the dual bottle allows for (see column 1, lines 5-15, in particular.)

Accordingly, one of ordinary skill in the art at the time the invention was made would have found it obvious to provide the composition of Beerse et al. in the two-container "kit" of Markey et al, because Markey et al. teaches that it is known to provide components of consumer products in separate containers before mixing the ingredients together. Accordingly, it is considered that one of ordinary skill in the art would have been motivated to provide the ingredients of the composition of Beerse et al. in the kit having the separate containers of Markey et al, with the expectation of providing a conventional and suitable means for the mixing and use of the composition.

Claims 44-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over either (1) U.S. Patent No. 5,098,694 to Komp et al, issued March 24, 1992, in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999, or (2) the article entitled "Enhanced Inhibition of *Listeria monocytogenes* by Glycerol Monolaurate with Organic Acids" by Oh et al, 1994, the Journal of Food Science, volume 59, no. 6, pages

Art Unit: 1617

1258-1261, in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999, or (3) U.S. Patent No. 5,968,539 to Beerse et al. in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999, as applied above, and further in view of U.S. Patent No. 5,965,088 to Lever et al, issued October 12, 1999.

The references are applied as discussed above, and teach deodorant and/or antibacterial compositions having the fatty acid monoester and acid, and which can be provided in a kit having two containers.

The references do not specifically teach providing a label or a package insert, as recited in claims 44-45.

Lever et al. teaches a disinfecting solution (see abstract, in particular.) Lever et al. teaches that it is known to include labels or package inserts to instruct users as to the properties and use of a disinfecting product (see paragraph bridging columns 20-21, in particular.)

Accordingly, it is considered that one of ordinary skill in the art would have found it obvious to provide a label or package insert describing the desired use and/or properties of the disinfecting/deodorizing/antimicrobial compositions as taught in the prior art as discussed above, with the expectation of providing a suitable product form for consumer use of the product.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 33-37, 39-45 and 52-54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-25 of copending Application No. 10/936,989.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to the same or substantially the same antimicrobial composition or kit comprising the same or substantially the same ingredients in the same or substantially same amounts.

Thus, the instant claims are seen to be obvious over the claims 1-25 of copending Application No. 10/936,989.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claims 33-37, 39-45 and 52-54 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-23 of copending Application No. 10/937,059 in view of U.S. Patent No. 5,862,949 to Markey et al, issued January 26, 1999

Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application is drawn to the same or substantially the same antimicrobial composition comprising the same or substantially the same ingredients in the same or substantially the same amounts. While the copending application does not specifically claim the composition as a part of a kit having two containers, Markey et al. teaches that it is known to provide such compositions in "kits" having two containers, as discussed above.

Thus, the instant claims are seen to be obvious over the claims 1-25 of copending Application No. 10/937,059 in view of the teachings of Markey et al.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have yet to be patented.

Claims 33-37, 39-45 and 52-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of U.S. Patent No. 5,460,833 to Andrews et al, in view of the teachings of the article by Ho et al. and U.S. Patent No. 5,862,949 to Markey et al, as discussed above.

The instant claims are not patentably distinct from those of the patented claims because the patented claims are to a disinfectant composition having the same fatty acid monoester as recited herein, and an acid that can be lactic acid, acetic acid, or others. The patented claims do not specifically recite benzoic acid or salicylic acid or a kit, as recited in the instant claims. However, as discussed above, Ho et al. teaches the suitability of organic acids such as lactic acid, acetic acid and benzoic acid as antimicrobials, and thus teaches the interchangeability of the acids taught therein for disinfecting/antimicrobial compositions. Accordingly, one of ordinary skill in the art would have found it obvious to replace one of the acids of the patented claims with benzoic acid, to arrive at the instantly claimed composition. Regarding the instantly claimed kit, Markey et al. teaches providing such containers for compositions, as has also been discussed above. Accordingly, claims 33-37, 39-45 and 52-57 are not

Art Unit: 1617

patentably distinct over claims 1-9 of U.S. Patent No. 5,460,833, in view of the Ho et al. and Markey et al.

Claims 33-37, 39-45 and 52-57 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of U.S. Patent No. 5,569,461 to Andrews et al, in view of the teachings of the article by Ho et al. and U.S. Patent No. 5,862,949 to Markey et al, as discussed above.

The instant claims are not patentably distinct from those of the patented claims because the patented claims are to a disinfectant composition having the same fatty acid monoester as recited herein, and an acid that can be lactic acid, acetic acid, or others. The patented claims do not specifically recite benzoic acid or salicylic acid or a kit, as recited in the instant claims. However, as discussed above, Ho et al. teaches the suitability of organic acids such as lactic acid, acetic acid and benzoic acid as antimicrobials, and thus teaches the interchangeability of the acids taught therein for disinfecting/antimicrobial compositions. Accordingly, one of ordinary skill in the art would have found it obvious to replace one of the acids of the patented claims with benzoic acid, to arrive at the instantly claimed composition. Regarding the instantly claimed kit, Markey et al. teaches providing such containers for compositions, as has also been discussed above. Accordingly, claims 33-37, 39-45 and 52-57 are not patentably distinct over claims 1-5 of U.S. Patent No. 5,569,461, in view of the Ho et al. and Markey et al.

Response to Arguments

Applicant's arguments with respect to the rejections of the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. IN particular, U.S. Patent No. 6,054,139 to Lambert et al. teaches that a cleaning and/or disinfecting composition can comprise an organic acid such as salicylic acid, acetic acid, sorbic acid, benzoic acid, lactic acid, citric acid, as well as others (see column 1, lines 40-55, in particular.)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Abigail M. Cotton whose telephone number is (571) 272-8779. The examiner can normally be reached on 9:30-6:00, M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan can be reached on (571) 272-0629. The fax

Art Unit: 1617

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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AMC


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